

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 21 and 39 were previously canceled and claims 32-34, 52, 69 and 87-89 are amended. Claims 1-20, 22-38 and 40-92 are pending in this application. Reconsideration is requested in view of the amendments and the remarks to follow.

The amendments to claims 32-34, 52, 69 and 87-89 address minor informalities noted during review. These amendments are not intended to alter the scope of the claims.

Election/Restriction

The Office Action states (pp. 2-3) that the claims are subject to a restriction requirement under 35 U.S.C. §121. The Office Action now alleges that the application embraces six patentably distinct inventions as noted below:

Group I, claims 1-7, 58, 61, 75 and 76, allegedly drawn to a system comprising a search server, an encoder and a client computer classified in class 709, subclass 203;

Group II, claim 8, allegedly drawn to a system comprising a search server, an encoder and a client computer classified in class 725, subclass 112;

Group III, claims 9-20, 59 and 62-74, allegedly drawn to a method comprising sending, to a search server, information identifying a live presentation, identifying, to the search server, when the live presentation is not longer available via the network, classified in class 725, subclass 116;

Group IV, claims 22-38, 46-54, 60 and 77-92, allegedly drawn to an apparatus and method comprising receiving information identifying a live presentation and making the information available for searching only during a duration of the live presentation, classified in class 725, subclass 146;

Group V, claims 40-45, allegedly drawn to one or more computer-readable media including identifying topic information, transmitting the set of search criteria to a server and receiving a list of live presentation currently in progress that match the search criteria, classified in class 725, subclass 114;

Group VI, claims 55-57, allegedly drawn to a method comprising identifying a set of search criteria to be compared to information describing a

plurality of live presentation, transmitting the set of search criteria to a server and receiving a list of live presentation currently in progress that match the search criteria, classified in class 725, subclass 86.

The Office Action (pp. 3-7, items 3-17) postulates various combination and subcombination relationships between the subject matter of Groups I-VI. Items 19(a)-19(f), page 7, indicate various potential search strategies as part of an effort to show that the searches would not be co-extensive.

Applicant hereby elects, with traverse, to prosecute claims 22-38, 46-54, 60 and 77-92 in the event that the restriction requirement is maintained. The election is made with traverse because the restriction requirement is improper and should be withdrawn. The reasons that the restriction requirement is improper are enumerated below. Any one of the reasons is sufficient to demonstrate that the requirement should be withdrawn. The combination of the reasons overwhelmingly supports withdrawal of the requirement as the only appropriate course.

Reason 1: Untimely

The Patent Rules state that a requirement for restriction "will be made before any action on the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." 37 C.F.R. §1.142(a).

In the current case, the restriction requirement was not made before any action on the merits, nor was it in the first Action on the merits or the second Action on the merits. Instead, the restriction requirement was not made until after

multiple Actions on the merits had been presented, and indeed following indication of allowable subject matter in the first Office Action.

The Office could have brought the restriction requirement in an earlier Action. The requirement could have been more easily considered at an earlier time in prosecution. Applicant has now expended considerable resources responding to arguments made on the merits of pending claims 1-20, 22-38 and 40-57, only to have this effort thwarted by a late-arriving restriction requirement.

The fact that some of the claims have been amended, and some new claims have been added, does not lessen the Office's obligation to bring the requirement in a timely fashion, particularly since the claims have not changed in substance in regards to the stated "distinctions". The Office alleges that claims 22-38, 46-54, 60 and 77-92 are drawn to "an apparatus and method comprising receiving information identifying a live presentation and making the information available for searching only during a duration of the live presentation". The stated distinctiveness of claims 22-38 and 46-54 was present in these claims as filed, prior to any clarifying amendments in the various responses. The same can be said for claims 1-20, 40-45 and 55-57.

Perhaps part of the problem may be due to the switch from Examiner Adegorusi to Examiner Lim. While Applicant appreciates that new Examiner Lim may have imposed the requirement sooner, Applicant should not be forced to break a case into multiple parts simply because the examiners differ in their opinion as to whether the claims should be subjected to a restriction requirement, or because one examiner now no longer supports a portion of the prosecution history as promulgated by another examiner.

Reason 2: No Prima Facie Evidence to Carry "Serious Burden"

The election requirement is improper because the Office offers no evidence demonstrating the represented conclusions of distinctiveness between inventions.

MPEP 803 states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; **and**
- (2) There must be a serious burden on the examiner if restriction is not required. (Emphasis added).

While the Office presents arguments for separate searches and for separate utility, the Office has not carried its serious burden by demonstrating *prima facie* evidence supporting independence of the subject matter of the various groups. MPEP 803 states that for "purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search." The Office offers no such *prima facie* evidence.

Indeed, in the instant application, the same Examiner has already shown that the searches are co-extensive in the Office Action dated June 19, 2003. Examiner Adegorsu made a similar showing in the Office Action dated December 20, 2002.

For example, in the former Office Action, claims 1-7, 9-12, 14, 15, 17, 20-25, 28, 31, 32, 36-38, 40-42 and 46-56 (and apparently claim 39) stood rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,930,473 to

Teng et al. (hereinafter "Teng"). Applicant notes cognitive dissonance in attempting to comprehend how subject matter embracing Groups I, III, IV, V and VI could suddenly become so disparate as to change from being allegedly anticipated by Teng to requiring separate searches. Group II, comprising claim 8, corresponds to claim 8 as originally filed, but amended to incorporate at least the recitation of claim 1 and thus cast in independent form in response to Examiner Adegorusi's explicit indication that such claim would then be allowable. Clarification is respectfully requested.

Reason 3: Without Carrying Its "Serious Burden", Office Must Examine Entire Application

MPEP 803 states that:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, *even though it includes claims to distinct or independent inventions.* (Emphasis added).

Applicant contends that all six groups can be conveniently searched and examined together without burden to the Office. As supporting evidence, the Office has already issued two Actions on the merits in this application, indeed even finding subject matter to be allowable over the art of record in the first Office Action. Accordingly, the Office must examine the entire application on the merits, even though it might include claims to distinct or independent inventions.

Reason 4: Unduly Burdensome on Applicant

Imposing a restriction requirement at this late stage in prosecution is unduly burdensome to Applicant. Applicant is forced to present a Response here, and if

the requirement is upheld, file and prosecute multiple separate applications on the merits. This results in a substantial financial burden on the Applicant for subject matter that can be handled effectively in one application, and in fact, has been handled in one application through multiple Office Actions. It is further noted that these extra costs are added to the expenses already levied on and mulcted from Applicant, which expenses are explicitly intended for examination of these claims.

For example, in the first Office Action, claims 8, 16, 18, 19, 26, 27, 29, 30, 33, 34, 42-45, 53, 54 and 57 were stated (Office Action Summary) to contain allowable subject matter. Claims 8, 16, 18, 19, 26, 29, 33, 34, 42, 43, 53, 54 and 57 were amended to place them in independent form and to include the recitation of the base claims and any intervening claims. Claims 27, 30, 35, 44 and 45 depend from such allowable claims and thus were also allowable. These claims thus were placed in allowable form, together with payment of appropriate fees.

In addition to the burden placed on the Applicant, the course of examination in this application appears to fail to further the constitutional purposes of the U.S. Patent Laws "to promote the progress of science and useful arts" (Article 1, Section 8). Clarification is respectfully requested.

Reason 5: Increased Burden on Office


Searching and examining six applications, where one application has sufficed for several Actions, dramatically increases the burden on the Office. The Office must make six duplicative searches, rather than one. Withdrawing the restriction requirement and keeping the claims together in one application would prove more efficient and effective for the Office in handling the subject invention.

Conclusion

Applicant respectfully requests withdrawal of the restriction requirement, and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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